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In re Application of McMURTRY et al :
U.S. Application No.: 10/518,918 :
PCT Application No.: PCT/GB03/02915 : DECISION
Int. Filing Date: 07 July 2003 :
Priority Date Claimed: 05 July 2002 :
Attorney Docket No.: 122070 :
For: LASER CALIBRATION APPARATUS :

This is in response to applicant's "Response to Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) Declaration Already Filed" submitted 24 August 2005, which is being treated as a petition under 37 CFR 1.181.

BACKGROUND

On 07 July 2003, applicant filed international application PCT/GB03/02915, which claimed priority of an earlier United Kingdom application filed 05 July 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 15 January 2004. The thirty-month period for paying the basic national fee in the United States expired on 05 January 2005.

On 23 December 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a purported declaration.

On 04 August 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 24 August 2005, applicant filed the present petition under 37 CFR 1.181, requesting acceptance of the declaration submitted on 23 December 2004.

DISCUSSION

The present response states that a declaration was submitted on 23 December 2004. A review of the application file reveals that a copy of a PCT Rule 4.17(iv) declaration filed in international application PCT/GB03/02915 is present. The International Bureau has informed the USPTO that a properly executed declaration filed under PCT Rule 4.17(iv) was submitted later than the international filing date. The PCT Rule 4.17(iv) declaration did not properly identify the international application to which it was directed, and thus the declaration which was filed in international application PCT/GB03/02915 cannot be applied to the present national stage application.

Furthermore, the declaration submitted on 23 December 2004, even if not considered to be a declaration under PCT Rule 4.17(iv) but rather an original submission under 37 CFR 1.497, does not satisfy the requirements of 37 CFR 1.497(a)(2).

MPEP 602 (VI) states in relevant part,

The following combinations of information supplied in an oath or declaration filed after the filing date of the application are acceptable as minimums for identifying a specification and compliance with any one of the items below will be accepted as complying with the identification requirement of 37 CFR 1.63:

- (A) application number (consisting of the series code and the serial number, e.g., 08/123,456);
- (B) serial number and filing date;
- (C) attorney docket number which was on the specification as filed;
- (D) title of the invention which was on the specification as filed and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or
- (E) title of the invention which was on the specification as filed and accompanied by a cover letter accurately identifying the application for which it was intended by either the application number (consisting of the series code and the serial number, e.g., 08/123,456), or serial number and filing date. Absent any statement(s) to the contrary, it will be presumed that the application filed in the USPTO is the application which the inventor(s) executed by signing the oath or declaration.

(Emphasis added.)

The declaration submitted on 23 December 2004 does not include any of the above combinations of information. A proper response to the Notification of Missing Requirements mailed 04 August 2005 remains due.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung

Bryan Tung
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: 571-272-3303
Facsimile: 571-273-0459